UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/092,791	06/05/1998	MATTHIAS EICHSTAEDT	AM9-98-023	6514

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EXAMINER
KANG, PAUL H

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _09 September 2003_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-13 and 15-39_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-13 and 15-39_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _05 June 1998_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1.   In light of the Decision on Appeal by the Board of Patent Appeals and Interferences

(Board) dated September 9, 2003 (paper no. 13), and because the examiner had specific

knowledge of the existence of a particular reference which indicated nonpatentability of the

appealed claims as to which the examiner was reversed, PROSECUTION IS HEREBY

REOPENED.

In reversing the Examiner's position on the merits of the present application, the Board

did not provide a reason for allowance for the claims in question, nor indicate any allowable

subject matter. The Board agreed with the Appellants, stating the examiner failed to meet his

burden of presenting a prima facie case of obviousness. Decision on Appeal, page 5.

In order to clarify the issues regarding the patentability of the present application, the

following rejections on the merits are presented:

2.   Claim 14 was previously cancelled. Claims 1-13 and 15-39 are now pending.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13 and 15-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Klug et al., US Pat. No. 5,996,007.

4.   As to claims 1, 15 and 27, Klug discloses a method and apparatus for alleviating problems associated with delays in accessing data on network (Klug, col. 1, line 62 – col. 3, line 67), comprising the steps of:

a) accessing data on a network from a client computer (Klug, col. 1, line 62 – col. 3, line 67);

b) identifying when a sufficient delay occurs during the accessing step (Klug, col. 1, line 62 – col. 3, line 67 and col. 7, line 34 – col. 8, line 39); and

c) presenting filler contents on the client computer during the identified sufficient delay, wherein the filler contents are customized to a user's taste (Klug, col. 1, line 62 – col. 3, line 67 and col. 7, line 34 – col. 8, line 39).

5.   As per claims 2, 5-7, 9-10, 28, 31-33 and 35-36, Klug discloses filler contents which can be automatically pre-selected from user interests obtained by web access history or from the accessed web page (Klug, col. 5, line 45 – col. 6, line 21).

6.   As per claims 3, 4, 29 and 30, Klug discloses filler contents selected from a group comprising text, graphics, audio, and audiovisual data. The filler data can be of any type of web content, static or dynamic (Klug, col. 1, line 62 – col. 3, line 67, col. 5, line 5 – col. 7, line 33 and

col. 7, line 34 – col. 8, line 39).

7.   As per claims 8, 18, 19, and 34, Klug discloses retrieving and storing the filler object on

the client (Klug, col. 5, line 45 – col. 6, line 21).

8.   As per claims 11 and 37, Klug discloses that the client computer identifies latency (Klug,

col. 7, line 34 – col. 8, line 39).

9.   As per claims 12, 13, 24, 25, 38 and 39, Klug discloses displaying the filler while the

original web page is downloaded and deactivates the filler when downloading is complete (Klug,

col. 1, line 62 – col. 3, line 67 and col. 7, line 34 – col. 8, line 39).

10.   As per claim 16, Klug discloses a browser for retrieving the embedded filler content from

a server (Klug, col. 5, line 45 – col. 6, line 21).

11.   As per claim 17, Klug discloses the browser (enabled to be filler engine/filler content

receiver) request and reception of the filler from a server (Klug, col. 1, line 62 – col. 3, line 67

and col. 7, line 34 – col. 8, line 39).

12.   As per claim 20, Klug discloses the use of cached filler content (Klug, col. 5, line 45 –

col. 6, line 21 and col. 7, line 51 – col. 8, line 5).

13.   As per claim 21, Klug discloses the use of filler content during latency experienced when

downloading web pages (Klug, col. 1, line 62 – col. 3, line 67 and col. 7, line 34 – col. 8, line

39).

14.   As per claim 22, Klug discloses the filler engine being an extension to the browser (Klug,

col. 5, line 45 – col. 6, line 4 and col. 7, line 34 – col. 8, line 39).

15.   As per claim 23, Klug discloses the filler engine as a component separate from the

browser, embedded in the downloaded web page (Klug, col. 5, line 45 – col. 6, line 4 and col. 7,

line 34 – col. 8, line 39).

16.   As per claim 26, Klug discloses the filler engine responding to information sent from the

server to display filler objects (Klug, col. 5, line 45 – col. 6, line 4 and col. 7, line 34 – col. 8,

line 39).

Claim Rejections - 35 USC § 103

17.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 1-13 and 15-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Judson, US Pat. No. 5,572,643, in view of Klug et al., US Pat. No. 5,996,007.

18.   As to claims 1, 15 and 27, Judson discloses the invention substantially as claimed. Judson

discloses a method and apparatus for alleviating problems associated with delays in accessing

data on network (Judson, col. 1, line 13 – col. 2, line 53), comprising the steps of:

a) accessing data on a network from a client computer (a client connected to a server

through a network [Judson, client/server network depicted in fig. 1] accesses web pages using

web browsers [Judson, fig. 2, element 62]; Judson, col. 1, line 13 – col. 2, line 53);

c) presenting filler contents on the client computer [during the accessing step] wherein

the filler contents are customized to a user's taste (latency-filler contents, customized on user

interest, are displayed during web page access; Judson, col. 5, line 50 – col. 6, line 24 and col. 7,

lines 2-17).

However, Judson does not specifically disclose step b) identifying when a sufficient

delay occurs during the accessing step. In the same field of endeavor, Klug teaches determining

the wait time associated with a particular web site access request and presenting wait time

messages based on the wait time (Klug, col. 2, line 63 – col. 3, line 16 and col. 7, line 34 – col. 8,

line 39).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to have incorporated the step of determining the wait time, as taught by

Klug, into the filler data display system of Judson, for the purpose of enhancing acceptability of

the system to end-users by increasing customization to user preferences and decreasing intrusion

to the Internet session.

19.   As per claims 2, 5-7, 9-10, 28, 31-33 and 35-36, Judson-Klug discloses filler contents

which can be automatically pre-selected from user interests obtained by web access history or

from the accessed web page (Judson, col. 6, line 62 – col. 7, line 17).

20.   As per claims 3, 4, 29 and 30, Judson-Klug discloses filler contents selected from a group

comprising text, graphics, audio, and audiovisual data. The filler data can be of any type of web

content, static or dynamic (Judson, col. 6, line 25 – col. 7, line 17).

21.   As per claims 8, 18, 19, and 34, Judson-Klug discloses retrieving and storing the filler

object on the client (Judson, col. 5, lines 16 – col. 6, line 11).

22.   As per claims 11 and 37, Judson-Klug discloses that the client computer identifies latency

(Klug, col. 2, line 63 – col. 3, line 16 and col. 7, line 34 – col. 8, line 39).

23.   As per claims 12, 13, 24, 25, 38 and 39, Judson-Klug discloses displaying the filler while

the original web page is downloaded and deactivates the filler when downloading is complete

(Judson, col. 5, line 50 – col. 6, line 12).

24.   As per claim 16, Judson-Klug discloses a browser for retrieving the embedded filler

content from a server (Judson, col. 6, line 62 – col. 7, line 17).

25.   As per claim 17, Judson-Klug discloses the browser (enabled to be filler engine/filler content receiver) request and reception of the filler from a server (Judson, col. 5, line 50 – col. 6, line 11).

26.   As per claim 20, Judson-Klug discloses the use of cached filler content (Judson, col. 5, lines 16-40).

27.   As per claim 21, Judson-Klug discloses the use of filler content during latency experienced when downloading web pages (Judson, col. 5, line 50 – col. 6, line 11).

28.   As per claim 22, Judson-Klug discloses the filler engine being an extension to the browser (Judson, col. 6, line 62 – col. 7, line 17).

29.   As per claim 23, Judson-Klug discloses the filler engine as a component separate from the browser, embedded in the downloaded web page (Judson, col. 5, line 50 – col. 6, line 24).
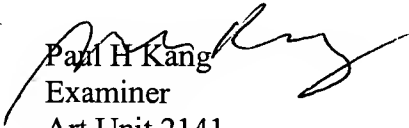
30.   As per claim 26, Judson-Klug discloses the filler engine responding to information sent from the server to display filler objects (Judson, col. 5, line 50 – col. 6, line 24).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Paul H Kang whose telephone number is (703) 308-6123. The

examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the

organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 305-3900.

/Paul H Kang/
Examiner
Art Unit 2141